REMARKS

Favorable consideration of this Application as presently amended and in light of the following discussion is respectfully requested. The applicant has rewritten the claims into proper U.S. form. After entry of the foregoing Amendment, Claims 1-17 are pending in the present Application. No new matter has been added.

By way of summary, the Official Action presents the following issues: Claims 1-4, 6, and 8-11 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Bechtold et al. (WO 01/65000, hereinafter Bechtold); Claims 5, 7, and 12-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bechtold and further in view of Marte et al. (WO 00/31334, hereinafter Marte); Claims 1, 2, and 4-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marte; Claims 3 and 9-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marte in view of Bechtold.

COMMENTS TO INTERVIEW SUMMARY

The applicant thanks the Examiner for permitting the applicant to interview this application on January 9, 2007. The applicant discussed how Bechtold does not anticipate the claims because Bechtold teaches electrochemical reduction rather than cathodic reduction. The applicant also discussed how neither Marte alone nor Marte and Bechtold in combination would have made the claims obvious because neither reference suggests cathodic reduction.

REJECTION UNDER 35 U.S.C. § 102

The outstanding Official Action has rejected Claims 1-4, 6, and 8-11 under 35 U.S.C. § 102 as being anticipated by Bechtold[1]. Applicant respectfully directs the examiner to a typographical error, wherein the § 102 rejection was made under § 102(e) rather than § 102(a) because Bechtold was not published in the English language. Applicant respectfully disagrees that Bechtold is an anticipatory reference under 35 U.S.C. § 102(a) for at least the following reasons.

Bechtold teaches a process for electrochemical reduction of dyes in an alkaline aqueous medium and also a process for dyeing cellulosic material with vat dyes or sulfur dyes by electrochemical dye reduction in the presence of metal complexes as mediators (see column 2, lines 44-47 of US 6,814,763 B2). This means that the dye, for example the sulfur dye, is reduced by a metal ion of the mediator system. After that the metal ion is regenerated cathodically and is again available for reducing dye. Accordingly, this is the prior art process as described on page 3, lines 16-23 of the present specification.

In contrast, the present invention works without the requirement of any mediator system, as the inventors have found that sulfur dyes can perform the function of the mediator (see page 3, lines 25-30 of the present specification). Accordingly, in the present invention the sulfur dye is not reduced by a metal ion of a mediator system, but instead is reduced directly at the cathode (note the language of present claim 1 ". . . the sulfur dye . . . being

[1]The applicant will refer to US 6,814,763 for the discussion of Bechtold because US 6,814,763 is the English counterpart and the national stage of WO 01/65000.

cathodically reduced in the electrolytic cell"). Accordingly, the present invention is novel over Bechtold and the § 102 rejection should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

Rejection under §103(a) as being unpatentable over Bechtold and further in view of Marte

The outstanding Official Action has rejected Claims 5, 7, and 12-15 under 35 U.S.C. § 103 as being unpatentable over Bechtold and further in view of Marte.

As the Examiner did not determine the teaching of Bechtold correctly (see above), this rejection is not proper. Neither Bechtold nor Marte teach or propose to reduce the sulfur dye cathodically in an electrolytic cell and also the combination of both does not lead to the present invention. Accordingly, for this reason alone this rejection should be withdrawn.

Rejection under §103(a) as being unpatentable over Marte

The outstanding Official Action has rejected Claims 1, 2, and 4-8 under 35 U.S.C. § 103 as being unpatentable over Marte.

Marte describes a process for the reduction of vat and sulfur dyes which includes the use of reaction starters, auxiliary agents and radical starters (see column 2, line 13 to column 5, line 5 of US 6,627,063). The inventive process does not require any starters and auxiliaries, but instead comprises reducing the sulfur dye cathodically in an electrolytic cell. It would not have been obvious to a person of ordinary skill of the art to forego the complex process of Marte in favor of

the process claimed in the present invention, nor is there any hint at how to arrive at the present invention's claimed process. Accordingly, this rejection should be withdrawn.

Rejection under §103(a) as being unpatentable over Marte in view of Bechtold

The outstanding Official Action has rejected Claims 3 and 9-15 under 35 U.S.C. § 103 as being unpatentable over Marte in view of Bechtold.

Bechtold does not teach a process for dyeing fiber materials, but instead teaches a process for reducing sulfur dyes. Consequently, Bechtold teaches a different subject matter from the subject matter of the present invention. It is true that the reduced sulfur dye obtained in that process can be used for dyeing in a subsequent step and said dyeing can even be performed in the catholyte reservoir of the reduction step. However, no reduction is necessary during dyeing and therefore the respective equipment is not in use during dyeing. Indeed, the examples provided in Bechtold illustrate that cathodic reduction takes place to remove oxygen **before** the dye is added to the chamber (see column 5, lines 65-67 through column 6, lines 1-4; column 6, lines 47-53; column 7, lines 31-37; and column 8, lines 13-16 of US 6,814,763).

The advantage of the Bechtold reduction process is that the sulfur dye is reduced to an extent which makes reduction during dyeing unnecessary. Thus, the teaching of Bechtold starts from a different approach to the dyeing problem and is unrelated to the technical problems to be solved with the present invention.

Likewise, a combination of Marte and Bechtold – assuming arguendo that the combination even would have been technically possible – would never arrive at the present invention. Accordingly, this rejection should be withdrawn.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless the prior art suggested the desirability of such modification (In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994); In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). Applicant disagrees with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the claimed invention.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the

prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Marte and Bechtold. For the above reasons, this rejection should be withdrawn.

CONCLUSION

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that the present Application is patently distinguished over the prior art, in condition for allowance, and such action is respectfully requested at an early date.

Applicant believes no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05579-00338-US from which the undersigned is authorized to draw.

Respectfully submitted,

CONNOLLY, BOVE,
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